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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,129	05/29/2001	Akiyuki Yoshisato	9281-4101	6504

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EXAMINER

GRAYBILL, DAVID E

ART UNIT

PAPER NUMBER

2827

DATE MAILED: 10/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/870,129

Applicant(s)

YOSHISATO ET AL.

Examiner

David E Graybill

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-8 is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5-24-01 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claim 1 limitation, "at least one of the capacitors is non-rectangular in shape formed from a plurality of rectangles and the extension projects from one side of another rectangle" must be shown or the features canceled from the claim.

To further clarify, as disclosed at page 24, lines 12-14, the capacitors C2 and C7 in Figure 2 comprise "another rectangle"; therefore, they are rectangular, thus Figure 2 does not show at least one of the capacitors is non-rectangular. Moreover, the capacitors illustrated in Figure 2, have edges, surfaces, and faces that meet at right angles; therefore, Figure 2 does not show at least one of the capacitors is non-rectangular.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly

connected, to make and/or use the invention. The undescribed subject matter is the claim 1 limitation, "at least one of the capacitors is non-rectangular in shape formed from a plurality of rectangles and the extension projects from one side of another rectangle." To further clarify, one skilled in the art would not be able to make a circuit comprising wherein at least one of the capacitors is non-rectangular in shape formed from a plurality of rectangles and wherein the extension projects from one side of another rectangle because the limitations, "at least one of the capacitors is non-rectangular in shape," and "the extension projects from one side of another rectangle" appear to be mutually exclusive, incompatible limitations.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In figure 1, the scope of the limitation, "at least one of the capacitors is non-rectangular in shape formed from a plurality of rectangles and the extension projects from one side

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of another rectangle" cannot be determined because the limitations, "at least one of the capacitors is non-rectangular in shape," and "the extension projects from one side of another rectangle" appear to be mutually exclusive, incompatible limitations.

In claims 3 and 4 the scope of the term "earth capacitor" is unclear because there is no art recognized definition of the term, and it is not otherwise explicitly defined in the disclosure.

Claims 3 and 4 have not been rejected over the prior art because, in light of the 35 U.S.C. 112 rejections supra, there is a great deal of confusion and uncertainty as to the proper interpretation of the limitations of the claims; hence, it would not be proper to reject the claims on the basis of prior art. As stated in *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962), a rejection should not be based on considerable speculation about the meaning of terms employed in a claim or assumptions that must be made as to the scope of the claims. See also MPEP 2173.06.

In the rejections infra, reference labels are generally recited only for the first recitation of identical claim language.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

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Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Haq (6146743) and Arai (6410960), or in the alternative, over the combination of Haq (6146743), Arai (6410960) and Shahani (6028990).

At column 9, lines 45-51 and 56-63, column 21, lines 1-21, and column 22, lines 32-28 and 41-45, Haq teaches the following:

1. An electronic circuit unit comprising: an alumina substrate 50; thin film circuit elements including capacitors, resistors, and inductance elements [not labeled] formed on the alumina substrate; thin film conducting patterns ["conductors," and 70, 72] connected to the circuit elements formed on the alumina substrate; a semiconductor chip mounted on the alumina substrate and wire bonded to the conducting pattern ["wire bonding of surface mount components"].

However, Haq does not appear to explicitly teach a bare chip.

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Nonetheless, at column 1, lines 61-67, Arai teaches a bare chip 204. In addition, it would have been obvious to combine the product of Arai with the product of Haq because it would provide a chip.

Also, Haq does not appear to explicitly teach the particular claimed capacitor shape. Notwithstanding, it would have been an obvious matter of design choice bounded by well known manufacturing constraints and ascertainable by routine experimentation and optimization to choose this particular shape because applicant has not disclosed that the shape is for a particular unobvious purpose, produces an unexpected result, or is otherwise critical, and it appears prima facie that the process would possess utility using another shape. Indeed, it has been held that mere dimensional limitations are prima facie obvious absent a disclosure that the limitations are for a particular unobvious purpose, produce an unexpected result, or are otherwise critical. See, for example, *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955); *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984); *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

In the alternative, at column 7, lines 23-32, Shahani teaches wherein a capacitor has an extension that is non-rectangular in shape formed from a plurality of rectangles and the extension projects from one side of another rectangle, and the non-rectangular shape has at least two rectangles that are combined together ["'L' shaped"]. Furthermore, it would have been obvious to combine the product of Shahani with the product of the applied prior art because it would provide a capacitor.

Claims 5-8 are allowed.

As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

The art made of record and not applied to the rejection is considered pertinent to applicant's disclosure. It is cited primarily to show inventions similar to the instant invention.

Any telephone inquiry of a general nature or relating to the status (MPEP 203.08) of this application or proceeding should be directed to Group 2800 Customer Service whose telephone number is 703-306-3329.

Any telephone inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Graybill at (703) 308-2947. Regular office hours: Monday through Friday, 8:30 a.m. to 6:00 p.m.

The fax phone number for group 2800 is 703/3087724.

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David E. Graybill
Primary Examiner
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D.G.
30-Sep-02